

09/725,386

MS160274.01

REMARKS

Claims 1, 5-12, and 15-25 are currently pending in the subject application and are presently under consideration. Claims 1, 12, 24, and 25 have been amended herein. Claims 1, 12, and 24 have been amended merely to make explicit that which is implicit or inherent in the claims. Claim 25 has been amended to include several limitations of claim 1. Consequently, the amendments do not raise new issues necessitating further search or undue consideration. A complete listing of the claims showing the changes made in revised amendment format can be found at pages 2-5 in accordance with 37 C.F.R. § 1.121. Entry of the amendments and favorable reconsideration of the subject application is respectfully requested in view of the comments contained herein.

I. Rejection of Claims 1, 12-14, 23, and 25 Under 35 U.S.C. § 103(a)

Claims 1, 12-14, 23, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Curtis (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,442,754). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Obviousness can only be established where there is some teaching or suggestion for the purposed modification or combination. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Moreover, *a reference that teaches away from the art is a per se demonstration of a lack of prima facie obviousness*. *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (emphasis added). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994); *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Curtis teaches identifying dependent components that need to be installed prior to installation of one or more depending components. Curtis fails to teach a dependency engine that, in response to a determination of improper dependency exists based on the selected components, *automatically adds necessary components to correct dependency* as recited by

09/725,386

MS160274.01

claims 1; *adding each component necessary* to ensure proper dependency between selected components *automatically when improper dependency exists* based on the components selected as recited by claim 12; a dependency engine being programmable to *automatically add each component necessary* to ensure proper dependency in response to determining that improper dependency exists as recited by claim 24; and *means for automatically adding components to correct dependency* of selected components as recited by claim 25. Rather, Curtis teaches away from automatically adding components to correct dependency as recited by the claims and as described by the secondary reference Cohen, *et al.* In particular, Curtis empowers a user to select (or not to select) to execute scripts to install dependent components after it is indicated and a user is notified that some dependent objects may not be installed. (See Col 3, line 50 through Col. 4, line 9). Accordingly, Curtis is not a proper reference and is not properly combinable with the secondary reference Cohen, *et al.* as the disclosure teaches away from the subject invention as claimed and Cohen, *et al.* Accordingly, the rejection of claims 1, 12 and 25 (as well as claims 5-11 and 15-23 depending therefrom) should be withdrawn and the claims allowed.

II. Rejection of Claims 5-8, 15-18, and 22 Under 35 U.S.C. § 103(a)

Claims 5-8, 15-18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Curtis (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,442,754) and further in view of Lewis, *et al.* (U.S. 5,761,380). Withdrawal of this rejection is respectfully requested for at least the following reason.

First, claims 5-8, 15-18, and 22 are allowable at least because Curtis and Cohen, *et al.* are not properly combinable as described *supra*. Cohen, *et al.* and Lewis, *et al.* fail to make up for the deficiencies of Curtis. Hence, this rejection should be withdrawn and the claims allowed.

III. Rejection of Claim 24 Under 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Curtis (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,442,754) and further in view of Lee, *et al.*

09/725,386

MS160274.01

(U.S. 6,158,001). Withdrawal of this rejection is respectfully requested for at least the following reason.

Curtis, *et al.* is not a properly combinable reference for the reasons set forth above. Lewis, *et al.* fails to make up for the deficiencies of Curtis. Accordingly, withdrawal of this rejection and allowance of claim 24 is respectfully requested.

IV. Rejection of Claims 9-11 and 19-21 Under 35 U.S.C. § 103(a)

Claims 9-11 and 19-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Curtis (U.S. 6,442,754) in view of Cohen, *et al.* (U.S. 6,442,754) and Lewis, *et al.* (U.S. 5,761,380) and further in view of Bunnell (U.S. 6,119,122). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 9-11 and 19-21 depend from claims 1 and 12. Curtis is not a properly combinable reference for the reasons set forth above. Lewis, *et al.* and Bunnell fail to make up for the deficiencies of Curtis. Accordingly, this rejection should be withdrawn for at least this reason.

Additionally, this rejection should be withdrawn because there is no suggestion or motivation to combine Bunnell with Curtis, Cohen, *et al.* and Lewis, *et al.*

The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F.2d at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

[T]he test is whether the combined teachings of the prior art, taken as a whole suggest the modifications to the person of ordinary skill in the art. *In re Napier*, 55 F.3d 610, 34 USPQ2d 1782 (Fed. Cir. 1995). Absent such a showing in the prior art, the examiner has impermissibly used the applicant's teachings to hunt through the prior art for the claimed

09/725,386

MS160274.01

elements and combine them as claimed. *In re Vaeck*, 947 F.2d 488, 20 USPQ 1438 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398 (Fed. Cir. 1989).

Bunnell discloses a method and apparatus for generically viewing and editing values and attributes associated of distributed objects. Without knowledge of the present invention, there is not proper motivation or suggestion to combine Bunnell with Curtis, Cohen, *et al.*, and Lewis, *et al.* to generate a system and method of planning installation of a plurality of application or service components as recited by the claims of the subject invention. Rather, it appears that the Examiner has improperly utilized the subject application as a blueprint to pick and choose references disclosing various claim limitations that when combined may produce the claimed invention. Thus, the purported obviousness conclusion based on the foregoing combination appears to be based on improper hindsight, in which the instant application provides the missing teaching and motivation for the combination. Accordingly, the rejection of claims 9-11 and 19-21 should be withdrawn.

09/725,386

MS160274.01

CONCLUSION

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone: (216) 696-8730
Facsimile: (216) 696-8731